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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 09/766,754      | 01/21/2001  | William G. Noles     | IRC288 (14060/197833) | 1258             |

23370 7590 06/04/2004

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EXAMINER

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3637

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,754

Applicant(s)

NOLES, WILLIAM G.

Examiner

Phi D A

Art Unit

3637

*mw*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Baltes (EP 297684 A1).

Baltes teaches all the claimed limitations of the above claims including an apparatus with an energy source or hot air gun (10), a structure (1), frame (9), guide (12, 13), and rollers (2).

The preamble of the claims are to an apparatus, thus any limitations to the modules carry little patentable weight. For example, the limitation of “contacting a textile face of the floor covering” is inherent since all structural limitations are met.

3. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hubbard et al (5935357).

Hubbard et al teaches all the claimed limitations of the above claims including an apparatus with an energy source or hot air gun (20), a structure (22), an adjustable frame or cradle (col 6 lines 1-5), guide (30, 32, col 5 lines 30-40), rollers (62, 64), handle (36), projecting arms (see figure 1) with rotating members (24).

The preamble claims an apparatus, thus any limitations to the modules carry little patentable weight. For example, the limitations of "contacting a textile face of the floor covering" are inherently met since all the structural limitations are met.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59155218 A in view of Baltes (EP297684).

JP59155218 teaches all the claimed limitations of the above claims except for the use of a hot air gun to apply heat and pressure. JP59155218 teaches cutting a carpet into required shape and applying heat and pressure to the edge of the textile pile face carpet tile to form a recess edge. Baltes (.684) teaches a method of positioning the hot air gun on the carriage (1) and moving across the floor covering (3), maintaining first reference structure (2) and second reference structure (12, 13) rotatable or hinged (col 2 lines 24-27).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify JP(...218) to show the use of the hot air gun as taught by Baltes to apply heat and pressure to the edge of the carpet tile to change the appearance since it is held to be within the skill of a worker in the art to select a known technique for ease of production of the carpet tile.

***Response to Arguments***

6. Applicant's arguments filed 3/12/04 to claims 1-20 have been fully considered but they are not persuasive.

7. Applicant states that Baltes is not capable of functioning as claimed, examiner respectfully disagrees. First of all, Baltes teaches all the claimed limitations. The claimed limitations met by Baltes certainly are capable of functioning as claimed when needed. With respect to the textile face and melting, these are not claimed limitations and thus the make up of the structures of the "textile" is unknown. Baltes' disclosure certainly could "melt or change the appearance" of a textile with "a certain property". Secondly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The argument is thus moot.

Applicant also states that Hubbard is not suitable or adaptable for use on textile face floor covering, examiner respectfully disagrees. Hubbard shows all the claimed limitations. The

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structures of Hubbard inherently are capable to function as claimed when needed. With respect to the textile face and melting, these are not claimed limitations and thus the make up of the structures of the "textile" is unknown. Hubbard's disclosure certainly could "melt or change the appearance" of a textile with "a certain property". Secondly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The argument is thus moot.

With respect to applicant's statements to Baltes and JP59155218A, examiner respectfully disagrees. First of all, both references teach the use of heat to effect a floor covering (carpet). Both references teach the supply and use of heat and energy on a floor covering. They are thus analogous art. Secondly, the combination of the references is motivated since the technique disclosed by Baltes is known and enables the ease of production of the carpet tile. Thus, the modification enhances the teaching of JP59155218A. The argument is thus moot.

With respect to applicant's argument that the combination of JP59155218A and Baltes do not show all the claimed limitations since Baltes does not teach or suggest a hot air gun capable of transferring heat to the textile face of the floor covering in an amount sufficient to melt a portion of the textile face, examiner respectfully disagrees. First of all, JP59155218A is the primary reference and Baltes is combined to show the hot air gun. The modification thus shows the JP..218 having a hot air gun. JP...218 teaches having a heat source sufficient to change the

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appearance of the edge of a carpet. The modification does not negate the JP..218 reference from maintaining the ability to cut and melt as disclosed. The use of a well-known method of hot air gun is just another means to achieve the cutting and melting described in JP...218. The argument is thus moot.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large circular flourish at the end.

Phi Dieu Tran A

5/31/04